

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

IN RE: COLUMBIA UNIVERSITY  
PATENT LITIGATION

04-MDL-1592  
This document relates to all actions

**JOINT REPORT PURSUANT TO  
THE COURT'S ORDER DATED SEPTEMBER 3, 2004**

The parties in the above-captioned multidistrict litigation respectfully submit the following joint report in accordance with the Court's Order dated September 3, 2004.

**A. Proposed Briefing Schedule for Columbia's Motion To Dismiss**

The parties were unable to agree on a schedule for opposition and reply regarding Columbia's Motion To Dismiss. The parties respectfully submit the following proposals.

Plaintiffs' Proposed Briefing Schedule. Plaintiffs propose that they file their opposition papers on September 16, 2004, in accordance with Local Rule 7.1(B)(2), and that Columbia file any reply by September 23, 2004. Columbia's proposal to shorten the briefing schedule would give plaintiffs a total of only five business days to prepare papers in opposition to a dispositive motion. Moreover, because Columbia did not file its motion until the Thursday afternoon before Labor Day Weekend, it was difficult or impossible for plaintiffs' counsel even to consult with their clients concerning the motion until this week. Plaintiffs are diligently proceeding with the

preparation of their opposition papers, but they believe they will need until September 16, 2004 to complete them.

Columbia's Proposed Briefing Schedule. Columbia believes that the Emergency Motion should be decided on an expedited basis in order to avoid incurring unnecessary litigation costs on supplemental expert reports, expert witness depositions, and summary judgment motions – costs that could be rather substantial. The law in this area is well settled and Columbia's motion is a mere ten pages. During the parties' telephone conference, Columbia proposed that plaintiffs serve their responses to the Emergency Motion on September 10 and that Columbia serve its reply on September 14. In the alternative, Columbia offered to agree to plaintiffs' proposed briefing schedule if plaintiffs agreed to a stay of proceedings in the case pending the outcome of the Emergency Motion. Given that plaintiffs are not prepared to submit a response by September 10, Columbia respectfully requests that the Court expedite the schedule to the extent possible to allow for a prompt resolution of the Emergency Motion.

Columbia provided plaintiffs with its covenant not to sue on Wednesday, September 1, and asked them to respond the next day regarding whether they would voluntarily dismiss their claims relating to the '275 patent. Not one plaintiff contacted Columbia to discuss the covenant or to ask for more time to address its implications. Because of this, Columbia filed its motion.

**B. Implications of Columbia's Covenant Not To Sue for the Possibility of a Settlement**

Plaintiffs' Statement. The prospects for settlement are difficult to assess at this stage, and may differ for each of the parties.

Columbia's Statement. Columbia is hopeful that the covenant not to sue will narrow the issues in dispute and allow for a constructive dialogue with plaintiffs. Columbia has been, and remains, willing to discuss settlement with plaintiffs at any time.

**C. Whether the Schedule Established in the Court's June 23, 2004 Order Should be Altered.**

Plaintiffs' Statement. Plaintiffs respectfully request that this matter proceed in accordance with the Court's June 23, 2004 Order, which established a schedule for speedy and efficient resolution of the narrow issue of whether the patent in suit is invalid for obviousness-type double patenting. Plaintiffs do not believe that Columbia's Covenant Not to Sue will moot this issue. Moreover, the Court, the many different attorneys involved in this case, and the expert witnesses who have been retained by the parties, long ago incorporated the dates specified in the Court's Order into their schedules, and subsequent scheduling decisions involving matters outside this litigation have been based upon those dates. Proceeding under the existing schedule while the Court considers Columbia's motion to dismiss will not prejudice any of the parties. However, if the proceedings are stayed pending resolution of the motion and the Court denies Columbia's motion, rescheduling the case on a similar fast track will be difficult and will significantly inconvenience the Court, counsel and the expert witnesses. Since Columbia could have filed its Covenant Not to Sue at any time in the course of this litigation, it would be grossly unfair to allow Columbia to derail the Court's carefully-crafted and long-established schedule by the mere filing of its motion.

Columbia's Statement. Columbia believes that it would be appropriate for the Court to stay the proceedings pending resolution of the Emergency Motion. Columbia believes that it makes little sense to continue litigating plaintiffs' double-patenting challenge on the expedited schedule adopted by the Court, when it is clear, under controlling Federal Circuit authority as discussed in this Court's March 6, 2004 Memorandum and Order in SVG Lithography Systems, Inc. v. Ultratech Stepper, Inc., that there is no longer any actual case or controversy between

plaintiffs and Columbia with respect to the '275 patent. During the parties' telephone conference, Columbia asked plaintiffs if they could articulate a reason why there is still a controversy as to the validity or enforceability of the '275 patent. Plaintiffs did not do so.

**D. Attorneys Participating in the September 9, 2004 Telephone Conference**

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Dated: September 8, 2004

Respectfully submitted,

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